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PAK, HANNAH J

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ELECTRONIC

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The applicants' arguments filed 11/10/2009 are fully considered but are not found persuasive. Specifically, the applicants argue that **(A)** the deionizing step of the present invention is distinguished as being different from that of Jonas et al. (see Page 2 of the Applicants' Remarks). The applicants refer to Example 1 of Jonas et al. to show differences between the deionizing step taught by Jonas et al. and the claimed deionizing step (see Page 2 of the Applicants' Remarks). The applicants also argue that **(B)** Jonas et al.'s method does not yield organic solvent dispersion of intrinsically conductive polymer which has a water content of below 1% (see Page 2 of the Applicants' Remarks). The applicants further argue that **(C)** Jonas et al. does not teach that carrying out ultrafiltration before the deionizing step (see Page 3 of the Applicant's Remarks).

With respect to argument **(A)**, the deionizing step recited in claim 1 can include the deionizing step taught by Jonas et al. so long as Jonas et al. teach the step of deionization, which involves deionizing the colloidal dispersion of water and clearing the polymer of cations using ion exchangers. Claim 2 further defines deionizing as using ion exchangers, which Jonas et al. teach. In addition, the claim also does not preclude the specific type of deionizing step taught by Jonas et al. Moreover, the example referred to by the applicants is not limited to the prior art, i.e. Jonas et al.

With respect to argument **(B)**, Jonas et al. teach that the water content in the organic solvent dispersion of the intrinsically conductive polymer to be preferably 0-5% by weight (Paragraph 80), which overlaps with the amount recited in claims 5 and 10

Art Unit: 1796

(below 1%). Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the invention was made, since it has been held that choosing the overlapping portion of the range taught by Jonas et al. and the range claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *MPEP* § 2144.05. The applicant must show that this particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. Also, the comparative example shown by the applicants does not show that the specific deionizing step taught by Jonas et al. would result in water content above 1%.

With respect to argument **(C)**, Jonas et al. teach carrying out the membrane process, such as ultrafiltration, and then repeating the step of deionizing the aqueous colloidal dispersion of water and clearing the polymer of cations using ion exchangers afterwards. See, e.g., paragraph 1 in the action mailed 2 February 2009 which, incidentally, was incorporated by reference in the final action mailed 10 August 2009. The repeating step of deionizing means the step was carried out twice, one before ultrafiltration and one afterwards. Moreover, the term, "comprising," recited in claim 1 does not exclude additional steps.

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